



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/941,682 | 08/30/2001 | Christian Mayaud | 58511-021 | 9565 |

20822 7590 07/05/2005

RUDEN, MCCLOSKEY, SMITH, SCHUSTER & RUSSELL, P.A.
P.O. BOX 1900
FORT LAUDERDALE, FL 33301

| |
|----------|
| EXAMINER |
|----------|

PORTER, RACHEL L

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3626

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/941,682

Applicant(s)

MAYAUD, CHRISTIAN

Examiner

Rachel L. Porter

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70 and 72-74 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 70 and 72-74 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. Claims 70 and 72-74 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 70 and 72-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for subject matter to be considered statutory, it must produce a useful, tangible, and concrete result. Exemplary claim 70 recites "a prescription created by..." The recited prescription is considered to be non-statutory, because it is not tangibly embodied on any media. Data structures not embodied on a computer-readable media are considered descriptive material.

Moreover, a prescription, per se is an abstract idea and is considered to be non-functional description matter even if stored upon tangible medium, because the prescription is incapable of producing a useful, tangible and concrete result. Even if drafted to be tangibly embodied on a computer-readable medium, for example, the prescription data alone would fail to define any structural and functional interrelationships between the "prescription" and other elements of a computer that permit any function to be realized. (See MPEP § 2106).

Art Unit: 3626

In light of the above, it is respectfully submitted that the claimed invention, does not have a tangible result, and thus fails to recite the practical application of an abstract idea to satisfy the requirements of 35 U.S.C. 101.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 70 and 72-74 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 70, it is unclear whether the applicant intends to claim the prescription or the prescription creation system. The current claim language suggests that the Applicant is attempting to claim a product-by-process or product-by-system (prescription by prescription creation system). However, it should be noted that only the components from the system which affect the resultant prescription will be given patentable weight and have art applied accordingly. In other words, the Examiner is interpreting the claims to mean that the Applicant is claiming the prescription, *not* the prescription creation system. Therefore, limitations which further define the prescription creation system but do not appear in the resultant prescription (i.e. captured in the prescription) will not receive patentable weight. (See MPEP 2113)

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 70 and 72-74 are rejected under 35 U.S.C. 102(e) as being anticipated by Schrier (USPN 5,833,599).

[claim 70] Schrier discloses a prescription created by a computer-implemented prescription creation system, said prescription being usable by a pharmacist to dispense drugs, comprising:

- electronic posting means to select and capture in said prescription:

- i) a patient identifier; (Figure 11; col. 13, lines 38-52; col. 14, lines 48-64)
- ii) a prescribed drug intended to treat a patient condition; (Figure 11; col. 13, lines 38-52; col. 14, lines 48-64)
- iii) a dosage for said prescribed drug; and (Figure 11; col. 13, lines 38-52; col. 14, lines 48-64)

The remaining limitations are drawn to the prescription creation system, not prescription. As such, these limitations will not be given patentable weight and will not distinguish the claimed prescription over the prior art of record.

Art Unit: 3626

[claim 72] Schrier teaches a prescription according to claim 70 wherein said electronic posting means further selects and captures in said prescription:

iv) the patient condition intended by said prescriber to be treated by said prescribed drug (col. 13, lines 6-10)

The remaining limitations are drawn to the prescription creation system, not prescription. As such, these limitations will not be given patentable weight and will not distinguish the claimed prescription over the prior art of record.

[claim 73] Schrier discloses a prescription according to claim 72 comprising a screen device to initiate dynamic assembly of a patient history record from elements retrieved from remote source databases, said patient history record being system-presented to the prescriber prior to completion of the prescription. (Figure 1, col. 6, lines 4-32; col. 13, lines 38-52)

[claim 74] Schrier discloses a prescription according to claim 73 wherein relevant drug and patient information is retrievable from remote source databases and can be system-presented to the prescriber prior to completion of the prescription. (Figure 1, col. 5, line 53-col. 6, line 32; col. 13, lines 38-52)


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is (571) 272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RP
RP


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600